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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,672	02/23/2004	Michael P. Whitman	11443/160	2683
26646 7590 12/02/2008 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004				
EXAMINER				
WEEKS, GLORIA R				
ART UNIT		PAPER NUMBER		
3721				
MAIL DATE		DELIVERY MODE		
12/02/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/785,672

Applicant(s)

WHITMAN ET AL.

Examiner

GLORIA R. WEEKS

Art Unit

3721

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 100-106 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 100-106 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. This action is in response to the remarks received on October 2, 2008

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 100-104 are rejected under 35 U.S.C. 102(b) as being anticipated by Toledano (USPN 5,855,312).

In reference to claims 100-104, figure 1 and column 3 line 65- column 6 line 59 of Toledano discloses a surgical device, comprising: a staple housing defining a bore; a trocar shaft disposed through the bore of the housing and extends distally¹ relative to a clamping face, so as to be moveable relative to the housing by operation of at least one driver within the housing; and an anvil attachable to the trocar shaft and configured to be moveable relative to the housing by movement of the trocar shaft, wherein the anvil includes an anvil shaft 140, the anvil shaft defining a trocar receiving slot, and the trocar shaft including a flexible trocar 22 configured to be insertable within the trocar receiving slot and the trocar receiving slot is defined in an anvil sleeve 16 having an axially-extending bore in communication with the trocar receiving slot, wherein the axially-extending bore has a wide portion into which the flexible trocar is insertable and a narrow portion which retains the trocar 22 within the axially-extending bore.

¹ **dis-tal** (dɪsˈtɑːl) *adj.* 1. Anatomically located far from a point of reference, such as an origin or a point of attachment. (American Heritage Dictionary)

4. Claims 105 and 106 are rejected under 35 U.S.C. 103(a) as being obvious over Toledano (USPN 5,855,312) in view of Whitman (USPN 6,491,201).

Regarding claims 104-106, the modified apparatus of Toledano discloses a surgical instrument having a rotatable driver 52 manually rotated by a knob 46, but does not disclose controlling rotation of the driver with a motor. Whitman teaches a surgical instrument having a flexible shaft (215) movable relative to a housing (155) by way of a rotatable driver (170) selectively rotated by at least one motor (165) via a controller (160). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the surgical instrument of Toledano include the motor rotatable driver of Whitman, as column 3 lines 17-31 of Whitman states that such a modification allows an operator to selectively and automatically control rotation of the driver.

Furthermore, It has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art.²

Response to Arguments

5. Applicant's arguments with respect to claims 100-106 have been considered but are moot in view of the new ground(s) of rejection.

² *In re Venner*, 120 USPQ 199.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to attachment for notice of references cited and recommended for consideration based on their disclosure of limitations related to the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GLORIA R. WEEKS whose telephone number is (571)272-4473. The examiner can normally be reached on M-F 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 3721

Other helpful telephone numbers are listed for applicant's benefit:

- Allowed Files & Publication (888) 786-0101
- Assignment Branch (800) 972-6382
- Certificates of Correction (703) 305-8309
- Fee Questions (571) 272-6400
- Inventor Assistance Center (800) PTO-9199
- Petitions/special Programs (571) 272-3282
- Information Help line 1-800-786-9199

/Gloria R. Weeks/

Examiner, Art Unit 3721

/Rinaldi I Rada/

Supervisory Patent Examiner, Art Unit
3721

December 1, 2008